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In re Application of SACCO et al :
U.S. Application No.: 09/486,660 :
Int. Application No.: PCT/IT98/00231 :
Int. Filing Date: 11 August 1998 :
Priority Date: 28 August 1997 :
Attorney Docket No.: 471-129P (previously SCBREV-223) :
For: TRANSGENIC ANIMALS FOR THE STUDY OF :
BIOLOGICAL, PHYSICAL, AND CHEMICAL :
TOXIC AGENTS : DECISION

This is in response to applicants' "Response to Notification of Missing Requirements" and "Petition Under 37 CFR 1.47" filed 24 October 2000, requesting that the present application be accepted for United States national stage processing without the signature of the guardian of one of the heirs of joint inventor Romeo Roncucci, who according to the petition is deceased. The communication is being treated as a request for status under 37 CFR 1.42 and a petition under 37 CFR 1.47(a) (collectively hereinafter "the response").

BACKGROUND

On 11 August 1998, applicants filed international application PCT/IT98/0023, which claimed priority of an earlier Italy application filed 28 August 1997. A copy of the international application was communicated to the USPTO from the International Bureau on 11 March 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 25 March 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 February 2000.

On 28 February 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 28 April 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge

under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 24 October 2000, applicants filed the present response along with the appropriate extension of time fee. The response states that it is accompanied by, *inter alia*: 1) a declaration executed by five of the six joint inventors, 2) a declaration executed by Sylvie Roncucci, one of the four heirs of Romeo Roncucci, 3) a declaration signed by Maria Novella Castagnoli, guardian of Rachele Roncucci and Regine Roncucci, two of the four heirs of Romeo Roncucci, 4) an affidavit of Peter Bromley, one of the joint inventors, 5) the surcharge set forth in 37 CFR 1.492(e), and 6) the petition fee set forth in 37 CFR 1.17(i).

DISCUSSION

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." The response states that deceased inventor Romeo Roncucci has four heirs: Sylvie Roncucci, Rachele Roncucci, Regine Roncucci, and Roxanne Roncucci.

Sylvie Roncucci

The declaration signed by Sylvie Roncucci is defective because it does not identify each inventor and the country of citizenship of each inventor as required by 37 CFR 1.497(a)(3). Furthermore, the declaration signed by Sylvie Roncucci does not state that the person making the declaration believes the named inventor(s) to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought as required by 37 CFR 1.497(a)(4).

Rachele Roncucci and Regine Roncucci

37 CFR 1.43 provides, "In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent." Applicants have submitted a declaration signed by Maria Novella Castagnoli, guardian of Rachele Roncucci and Regine Roncucci, who according to the response are minors.

The declaration signed by Maria Novella Castagnoli is defective because it does not identify each inventor and the country of citizenship of each inventor as required by 37 CFR 1.497(a)(3). Furthermore, the declaration signed by Maria Novella Castagnoli does not state that the person making the declaration believes the named inventor(s) to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought as required by 37 CFR 1.497(a)(4).

Roxanne Roncucci

The response states that applicants have been unable to obtain the signature of Anne Georgette Christiane Delachet, guardian of Roxanne Roncucci, who according to the response is a minor.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by joint inventors Maria Grazia Sacco, Luigi Zecca, Libero Clerici, Paolo Vezzoni, and Peter Bromley. This declaration is improper because it does not identify Romeo Roncucci as an inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a copy of the application papers (including specification, claims, drawings, and oath or declaration) to Ms. Delachet for signature. Mr. Bromley states that Italian patent attorneys had difficulty in obtaining execution of the declaration which was attached to a copy of the application

papers (see page 1 of Mr. Bromley's affidavit) but does not specify whether the application papers were actually presented to Ms. Delachet. Applicants have not provided an affidavit or declaration of the Italian attorneys who have firsthand knowledge of attempts to present a copy of the application papers to Ms. Delachet. Furthermore, Mr. Bromley states that "the documents to be signed" were enclosed in letters that he sent on 19 October 2000 and 20 October 2000 to Ms. Delachet (see page 3 of Mr. Bromley's affidavit) but does not specify whether the enclosed documents included the complete application papers. Moreover, applicants have not provided documentary evidence that the letters were successfully delivered to Ms. Delachet.

In addition, applicants have not sufficiently established that Ms. Delachet's conduct constitutes a refusal to sign the application papers. Mr. Bromley states that he has received "documentation from the CNR lawyers showing that they had made numerous written communications and phone conversations with Ms. Delachet" (see page 2 of Mr. Bromley's affidavit) but documentary evidence of such communications has not been provided. Such documentary evidence should be supported by an affidavit or declaration by the parties having firsthand knowledge of the communications. Also, Mr. Bromley has not provided details concerning the result of his planned personal trip to see Ms. Delachet on 20 October 2000 (see page 3 of Mr. Bromley's affidavit).

Additionally, Mr. Bromley's statement that he received information from an Italian lawyer who had received "information from the CNR that one of Romeo Roncucci's ex wives was the person who was refusing to sign" the declaration (see page 2 of Mr. Bromley's affidavit) is unacceptable hearsay. The circumstances of an alleged express refusal must be detailed in an affidavit or declaration by the person to whom the refusal was made.

With regard to item (3) above, although the response states that the requisite petition fee was submitted with the response, USPTO records indicate that no petition fee has been associated with the present application. Therefore, the petition fee will be charged to Deposit Account No. 02-2448 as authorized in the response.

With regard to item (4) above, the response does not state the last known address of Anne Georgette Christiane Delachet.

CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 and the petition under 37 CFR 1.47(a) are DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should

include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42 and Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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